



Paper No. 6

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OFFICE OF PETITIONS

In re Application of  
Estipona  
Application No. 09/823,513  
Filed: March 30, 2001  
Attorney Docket No. 042390.P8786X

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: DECISION DISMISSING  
: PETITION  
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This is a decision on the petition under 37 CFR 1.47(b), filed on August 6, 2001, requesting that Intel Corporation ("Intel") be allowed to make the application on behalf of and as agent for the sole inventor who allegedly refuses to execute the application.

The petition is **DISMISSED**.

The sole inventor for the claimed invention in this application is Jim B. Estipona ("Estipona"), who is or was employed by Intel.<sup>1</sup> On May 17, 2001, the Office of Initial Patent Examination (OIPE) mailed a Notice to File Missing Parts of Nonprovisional Application ("5/17/01 Notice") stating that the declaration filed with the application on March 30, 2001 was not signed by the inventor. The instant petition was filed in response to the 5/17/01 Notice.

Under 37 CFR 1.47(b), if the sole inventor refuses to execute an application for patent, a person<sup>2</sup> to whom the inventor has assigned or **agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest** in the patent application,<sup>3</sup> may make application on behalf of and as agent for this inventor. Furthermore, the oath or declaration in such an application **must** be accompanied by a petition that includes, *inter alia*, **proof** of the pertinent facts; the **last known address** of the inventor;<sup>4</sup> and a **showing** that such action is necessary to **preserve the rights of the parties or to prevent irreparable damages**.<sup>5</sup>

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<sup>1</sup> It is not clear whether Estipona is still employed by Intel. See petition page 2, paragraph 4.

<sup>2</sup> A "person" can be a natural person or a legal entity such as a corporation; see MPEP section 409.03(b) (8th ed. Aug. 2001).

<sup>3</sup> See also MPEP sections 409.03(b), (f) (8th ed. Aug. 2001).

<sup>4</sup> This has been provided in the instant petition; see petition page 2.

<sup>5</sup> 37 CFR 1.47(b). See also MPEP section 409.03(g) (8th ed. Aug. 2001): "Irreparable damage may be established by a **showing (statement)** that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage." (emphasis added) Such a statement is included in the instant petition; see petition page 2, paragraph 5.

The Office notes that:

-When an employment agreement is relied upon to show that the employee (nonsigning inventor) has agreed to assign the invention to the 37 CFR 1.47(b) applicant (employer, e.g., a corporation), it **must** be established by a **statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.**<sup>6</sup> The petition encloses a copy of an employment agreement between Intel and Estipona, executed on March 23, 1998 ("Agreement"), apparently to show that Estipona has agreed, through this Agreement, to assign rights to this invention to Intel. This Agreement, being a general employment agreement, makes no reference to the claimed invention in this application. Nor does the petition indicate when the claimed invention was made by Estipona, and whether it was made during Estipona's employment by Intel. Therefore, the instant petition **fails to demonstrate, as required by 37 CFR 1.47(b), that Estipona has agreed to assign the invention in this application to Intel, or that Intel otherwise has the requisite proprietary interest in this application to justify filing the application on behalf of and as agent for Estipona;**

-A 37 CFR 1.47 applicant is required to **present an entire copy of the application papers**, including specification, claims, drawings, and oath or declaration, to the nonsigning inventor before a petition under 37 CFR 1.47 is granted.<sup>7</sup> Also, to allege refusal to sign the application by the inventor, the circumstances of the presentation of the application papers to, and the refusal to sign the papers by, the inventor must be specified in a **statement of facts** by the person who presented the application/concluded that the inventor refused to sign/**to whom** the refusal was made.<sup>8</sup> The instant petition is accompanied by a declaration by Charles A. Mirho ("Mirho Declaration"), one of the attorneys-of-record apparently appointed by Intel to prosecute this application. The Mirho Declaration states that "[o]n July 18, 2001, via an e-mail communication, Estipona refused to sign the Declaration and Power of Attorney"<sup>9</sup>, but **does not indicate whether an entire copy of the application papers**, including specification, claims, drawings, and oath or declaration, **had been presented to Estipona** for signature prior to the alleged e-mail communication.<sup>10</sup> Neither does the petition include any **proof**, as required by

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<sup>6</sup> See MPEP section 409.03(f) (8th ed. Aug. 2001).

<sup>7</sup> MPEP section 409.03(d) (8th ed. Aug. 2001) (Refusal to join).

<sup>8</sup> *Id.*

<sup>9</sup> Paragraph 5, Mirho Declaration.

<sup>10</sup> See MPEP section 409.03(d) (8th ed. Aug. 2001) (A refusal by an inventor to sign an oath or declaration when the inventor has **not** been presented with the application papers **does not** itself suggest that the inventor refuses to join in the application **unless** it is clear that the inventor understands exactly what

37 CFR 1.47(b), that Estipona refuses to sign the oath or declaration in this application,<sup>11</sup> and the reason for such refusal, if any is given.<sup>12</sup>

The instant petition is thus dismissed.

To prevent abandonment of this application,<sup>13</sup> a request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mailing date of this decision. To be grantable, the renewed petition (no fee) must include:

- Appropriate **proof** that Estipona **made the claimed invention** in this application **while employed by Intel**, and has **agreed in writing to assign such invention to Intel**;<sup>14</sup> or that Intel otherwise has sufficient proprietary interest in this application to justify the filing of this application on behalf of and as agent for Estipona;<sup>15</sup>
- Appropriate statement(s) of facts regarding the presentation of **the entire application papers**, including the specification, claims, drawings, and oath or declaration, to Estipona;<sup>16</sup> and the circumstances of the alleged refusal by Estipona to sign the papers presented, or the **facts** relied upon to conclude that Estipona refuses to sign

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he is being asked to sign and refuses to accept the application papers.) (emphasis added)

<sup>11</sup> In applications with 37 CFR 1.47 petitions, the USPTO presently does not accept e-mail communications to non-signing inventors as proof of presentment of the applications to, or refusal to sign the applications by, the inventors.

<sup>12</sup> If the nonsigning inventor gives a reason for refusing to sign the oath or declaration for the application, that reason should be stated in the petition; see MPEP section 409.03(d) (8th ed. Aug. 2001).

<sup>13</sup> See 37 CFR 1.53(f) (If an application which has been accorded a filing date . . . does not include an oath or declaration by the applicant pursuant to §1.63 . . . , applicant will be notified and given a period of time within which to . . . file an oath or declaration . . . and pay the surcharge required by §1.16(e) to avoid abandonment). The 5/17/01 Notice set forth a 2-month reply period for submitting a signed oath or declaration for this application, extendable for up to 5 months under 37 CFR 1.136(a) (see MPEP section 710.02(d) (8th ed. Aug. 2001); This 5-month period may be further extended under 37 CFR 1.136(b) when appropriate). The instant petition includes a request for a 1-month extension of time. Applicant thus has until 12/17/01 (with a 4-month extension of time under 37 CFR 1.136(a)) to submit a properly signed oath or declaration, through the grant of a renewed petition under 37 CFR 1.47(b) or otherwise.

<sup>14</sup> See note 6, *supra*.

<sup>15</sup> See note 3 and accompanying discussion, *supra*.

<sup>16</sup> E.g., proof that a *bona fide* attempt was made to present a copy of the application to Estipona, but he refused to accept delivery of the papers or expressly stated that the papers should not be sent; see MPEP section 409.03(d) (8th ed. Aug. 2001); see also note 7, *supra*. (Note: e-mail communications not acceptable; see note 11, *supra*.)

this application;<sup>17</sup> such statement(s) of facts being made and signed by **those who presented the application/concluded that Estipona refused to sign/to whom the refusal to sign was made;**

-An oath or declaration in compliance with 37 CFR 1.63, and **signed** by an officer of Intel<sup>18</sup> or by a person authorized by Intel to sign on its behalf.<sup>19</sup>

The Office acknowledges receipt of the \$130 petition fee, the \$130 surcharge for late filing of an oath or declaration, and the \$110 for a 1-month extension of time for responding to the 5/17/01 Notice.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By fax: (703)308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to Petitions Attorney RC Tang at (703) 308-0763.



Beverly M. Flanagan  
Supervisory Petitions Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>17</sup> MPEP section 409.03(d) (8th ed. Aug. 2001).

<sup>18</sup> With title identified. MPEP section 409.03(b) (8th ed. Aug. 2001).

<sup>19</sup> Must submit proof for, or statement of, such authority. MPEP section 409.03(b) (8th ed. Aug. 2001).